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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,910

03/21/2006

Sui Xiong Cai

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7590

04/04/2008

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EXAMINER

VAKILI, ZOHREH

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

04/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,910	Applicant(s) CAI ET AL.	
	Examiner ZOHREH VAKILI	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/26/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION**Claims 1-33 are presented for examination**

Applicant's response to the election/restriction requirement filed on July 26, 2007 is acknowledged. Accordingly, Applicant elects Group V represented by claims 27-33 with traverse. Applicant also elects 2-(3,5-Dichloro-2-(2-morpholin-4-yl-ethoxy)-benzylidene)-N-(2-chloro-4-pyridyl)-N'-(3-trifluoromethyl-phenyl)-malonamide as the specie with traverse.

Because the applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03 (a)). The requirement is still deemed proper and is therefore made FINAL

Claims 27-33 encompass the elected invention and are herein examined on the merits. Claims 1-26 are withdrawn from consideration as being directed to non-elected subject matter.

The requirement for election of specie is hereby withdrawn, there is no prior art of record teaching or suggesting the elected specie.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1614

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-29 and 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Satoh et al. (P/N 4634777)

Satoh et al. disclose of an invention that is directed to the compounds of the general formula (see abstract). Further Satoh et al. disclose the compound of formula I which is within the scope of the claimed specie: N,N'-Bis-(3-carboxy-phenyl)-2-benzylidene-malonamide (see col. 14, lines 25-30). Satoh et al. generically disclosed and claimed the instant claims.

Consequently, the reference anticipates the claimed invention defined in claims 27-29 and 31-32.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any

Art Unit: 1614

inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh et al. (US Pat. No. 4634777) (cited on IDS).

Satoh et al. disclose of an invention that is directed to the compounds of the general formula (see abstract). Further Satoh et al. disclose the compound of formula I which is within the scope of the claimed specie: N,N'-Bis-(3-carboxy-phenyl)-2-benzylidene-malonamide (see col. 14, lines 25-30). Satoh et al. generically disclosed and claimed the instant claims.

It would have been obvious to one of ordinary skill in the art to use the teachings of Satoh et al. to generate the claimed compound.

One would have been motivated to create such a compound because Satoh et al. teach the generic formula for the compound. Furthermore, Satoh et al. teach one of the claimed species of the compound. Therefore, one of ordinary skill in the art would have been motivated to use the general formula taught by Satoh et al. to develop the compound as claimed.

Finally, one would have a reasonable expectation of success given that Satoh et al. provide a detailed blueprint for making the compound, and the steps of which are routine to one of ordinary skill in the art.

Art Unit: 1614

Thus in the absence of evidence to the contrary, the invention of claims 27-33 would have been prima facie obvious as a whole to one of ordinary skill in the art at the time the invention was made.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh Vakili whose telephone number is 571-272-3099. The examiner can normally be reached on 8:30-5:00 Mon.-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili

Art Unit: 1614

Patent Examiner
1614

March 21, 2008

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614